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PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q60969

Hideo WATANABE, et al.

Appln. No.: 09/667,301

Group Art Unit: 3711

Confirmation No.: 1597

Examiner: Alvin A. HUNTER

Filed: September 25, 2000

For: SOLID MULTI-PIECE GOLF BALL

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellants respectfully submit this Reply Brief in response to the Examiner's Answer dated March 10, 2005. Entry of this Reply Brief is respectfully requested.

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STATUS OF CLAIMS

Claims 1, 6-12 and 14-18 are pending. All claims stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Higuchi et al. (Japanese Patent Application Publication No. 11-253578) [“Higuchi”]. Claims 1, 6-12, and 14-18 are being appealed and were set forth in their entirety in the Claims Appendix submitted with Appellants’ Brief on Appeal filed on December 6, 2004

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.:09/667,301

Attorney Docket No.: Q60969

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 6-12 and 14-18 stand rejected under 37 C.F.R. § 103(a) as being unpatentable over Higuchi *et al.* (JP 11-253578) [“Higuchi”].

ARGUMENT

In the Response to Arguments section, the Examiner contends the following:

Appellant's [sic] quotes *In re Wilson* stating that "All words in a claim must be considered in judging the patentability of that claim against the prior art." The rejection above sets forth that polyurethane elastomer is the primary material. The additional language regarding the polyamide, polyester, and ionomer within the rejection only implies that though polyurethane elastomer is the main material used, these additional materials may be added thereto. The appellant's claims does [sic] not require the thermoplastic elastomer, that is the main material, to be the only material within the intermediate layer. It appears that the appellant clearly chose to ignore the arguments made within the final rejection and chose to create an issue totally different from the issue at hand. **The issue is whether the Markush group (i.e. the thermoplastic elastomer consisting from the group of polyether, polyamide, polyolefin, and polystyrene) from which the material consisted is broad enough to be encompassed by the prior art. Higuchi discloses a polyurethane elastomer, which is a thermoplastic elastomer, made of a polyether polyol system. In other words, Higuchi clearly teaches "a thermoplastic elastomer consisting of polyether." This clearly meets the limitation claimed by the appellant regarding the intermediate layer composition.**

(Bold added for emphasis).

Examiner's Answer at pages 5-6.

To summarize, the Examiner contends that because a polyurethane elastomer may be made from a polyether¹ polyol system, the polyurethane elastomer meets the limitation of "a thermoplastic elastomer consisting of polyether." Appellants disagree.

¹ We believe that the Examiner means to state polyester, which is recited in the claims, not polyether, which is not recited.

Claim 1 recites that “the mantle is made of a material composed primarily of a thermoplastic elastomer selected from the group consisting of polyester, polyamide, polyolefin, and polystyrene. Appellants submit that the Examiner is again ignoring words in a claim. Specifically, the Examiner is ignoring that the “thermoplastic elastomer [is] selected from the group consisting of polyester, polyamide, polyolefin, and polystyrene,” not merely that the thermoplastic elastomer may consist of polyester, polyamide, polyolefin or polystyrene.

Here, Higuchi clearly discloses (and the Examiner readily concedes) that the primary material forming the intermediate layer (the alleged mantle) is a polyurethane elastomer. Accordingly, Appellants submit that the polyurethane elastomer cannot be a thermoplastic elastomer that is selected from the claimed group since the claimed group does not recite “polyurethane.”

Although claims should be given their broadest reasonable interpretation, the interpretation must be consistent with the interpretation that those skilled in the art would reach. MPEP § 2111 at 2100-47. Appellants submit that one skilled in the art would not interpret the claim language as including a polyurethane elastomer as the claimed thermoplastic elastomer.

With respect to the claimed compression ratio, the Examiner contends the following:

Higuchi clearly and inherently encompasses the appellant's ratio. As shown in the above rejection, the core and intermediate layers' compressions are revealed to be of the same range, i.e. 3.2 to 5.2mm. One having ordinary skill in the art clearly would draw therefrom that the compression ratio can be of any value, even 1, **so long as the invention disclosed by Higuchi is attained.** Appellant has submitted a declaration showing the compression ratio of Higuchi in which the appellant alleges shows the instant invention being unobvious. The declaration contains the golf balls

used within the examples disclosed in the Higuchi reference and would appear not to obviate over the prior art being that the prior art can not be limited to only the illustrative examples. Prior art is relevant for all of which is contains (See MPEP 2123). As it stands, the appellant has not shown that the compression ratio claimed by the appellant is unobvious. The examiner assures and concludes that the above required no hindsight.

(Bold added for emphasis).

Examiner's Answer at page 6.

Appellants submit that mere "identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). Here, Appellants clearly showed, with the use of Mr. Watanabe's Declaration, that the only example golf ball of Higuchi that meets the claimed compression ratio would not meet at least the claimed compression of the core. Accordingly, Appellants submit that the Examiner has not shown how the "invention disclosed by Higuchi is attained" while still maintaining the claimed features of the present invention as set forth in claim 1.

Although the prior art is relevant for all that it teaches, the prior art must be considered as a whole, including portions that would teach away from the claimed invention. See MPEP § 2104.02 at 2100-127. Since the Examiner has not rebutted Appellants' argument that Higuchi does not disclose a golf ball with the claimed compression ratio in combination with the other claimed elements, Appellants submit that Higuchi arguably teaches away from the combination of features as set forth in claim 1. Accordingly, the claimed invention as a whole is unobvious.

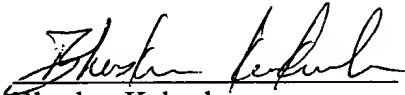
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CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellants respectfully request that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,


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